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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,474	10/20/2003	Bruce P. Konen	1110-0462	7873

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EXAMINER

FLORES SANCHEZ, OMAR

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/689,474

Applicant(s)

KONEN, BRUCE P.

Examiner

Omar Flores-Sánchez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 8 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/20/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over McHenry (2256779).

McHenry discloses the invention substantially as claimed including a power drill (see Fig. 1), a chunk 14, a handle 11, first and second cutting blades (45 and 50), a drive assembly including a drive shaft 16, a torque arm 22, a torque arm clamp (24-26) and an attachment element comprises a hook 19. McHenry doesn't show the torque arm attached to the handle; instead it is attached to the housing 10, which is integrally molded with the handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify McHenry's torque arm by attaching to the handle, since the operation of the device would not be affected and it has held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

3. Claims 1, 3, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of McHenry (2256779).

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You discloses the invention substantially as claimed including housing 10, first and second cutting blades (20 and 30) and a drive assembly including a drive shaft 42. You does not show a torque arm, a torque arm clamp and an attachment element comprises a hook. However, McHenry teaches the use of a torque arm 22, a torque arm clamp (24-26) and an attachment element comprises a hook 19 for the purpose of better supporting the cutter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the torque arm, the torque arm clamp and the hook as taught by McHenry in order to obtain a better support.

Also, McHenry doesn't show the torque arm attached to the handle; instead it is attached to the housing 10, which is integrally molded with the handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify You's torque arm by attaching to the handle, since the operation of the device would not be affected and it has held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of McHenry (2256779) as applied to claim 1 above, and further in view of Lazarevic (6065212).

The modified device of You discloses the invention substantially as claimed including a worm 41. You does not show a worm gear, a drive gear and a main shaft. However, Lazarevic teaches the use of a worm gear 28, a drive gear 64 and a main shaft (See Fig. 10) for the purpose of obtaining a large torque, which increase the cutting force. It would have been obvious to one

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having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the worm gear, the drive gear and the main shaft as taught by Lazarevic in order to obtain a large torque which increase the cutting force.

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of McHenry (2256779) as applied to claim 1 above, and further in view of Rudolf et al. (6155916).

The modified device of You discloses the invention substantially as claimed except for a stabilizing handle that can be attached to left and right sides. However, Rudolf et al. teach the use of a stabilizing handle 30 that can be attached to left and right sides (see Fig. 1) for the purpose of allowing right and left hand operators use the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's device by providing the stabilizing handle as taught by Rudolf et al. in order to obtain a device that can be use by right and left hand operators.

6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McHenry (2256779) as applied to claim 1 above, and further in view of Rudolf et al. (6155916).

The modified device of McHenry discloses the invention substantially as claimed except for a stabilizing handle that can be attached to left and right sides. However, Rudolf et al. teach the use of a stabilizing handle 30 that can be attached to left and right sides (see Fig. 1) for the purpose of allowing right and left hand operators use the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified

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McHenry's device by providing the stabilizing handle as taught by Rudolf et al. in order to obtain a device that can be use by right and left hand operators.

7. Claims 9, 15-16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212).

You discloses the invention substantially as claimed including a worm 41, housing 10, first and second cutting blades (20 and 30), a drive assembly including a drive shaft 42, a cut away portion 12 and a segment gear 35. You does not show a worm gear, a drive gear and a main shaft. However, Lazarevic teaches the use of a worm gear 28, a drive gear 64 and a main shaft (See Fig. 10) for the purpose of obtaining a large torque, which increase the cutting force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the worm gear, the drive gear and the main shaft as taught by Lazarevic in order to obtain a large torque which increase the cutting force.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212) as applied to claim 9 above, and further in view of McHenry (2256779).

The modified device of You discloses the invention substantially as claimed except for a torque arm. However, McHenry teaches the use of a torque arm 22 for the purpose of better supporting the cutter. It would have been obvious to one having ordinary skill in the art at the

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time the invention was made to have modified You's cutter by providing the torque arm as taught by McHenry in order to obtain a better support.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212) as applied to claim 9 above, and further in view of Rudolf et al. (6155916) and McHenry (2256779).

The modified device of You discloses the invention substantially as claimed except for a stabilizing handle that can be attached to left and right sides and a torque arm. However, Rudolf et al. teach the use of a stabilizing handle 30 that can be attached to left and right sides (see Fig. 1) for the purpose of allowing right and left hand operators use the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's device by providing the stabilizing handle as taught by Rudolf et al. in order to obtain a device that can be use by right and left hand operators.

Regarding to the torque arm, McHenry teaches the use of a torque arm 22 for the purpose of better supporting the cutter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the torque arm as taught by McHenry in order to obtain a better support.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over You (5067240) in view of Lazarevic (6065212) as applied to claim 9 above, and further in view of Hirabayashi (5642566).

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The modified device of You discloses the invention substantially as claimed except for a brush. However, Hirabayashi teaches the use of a brush 8 for the purpose of maintaining the dust away of the gears. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified You's cutter by providing the brush as taught by Hirabayashi in order to maintain the dust away the gears.

11. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirabayashi (5642566).

Hirabayashi discloses (fig. 1-25) the invention substantially as claimed including a housing 3, first and second cutting blades (1 and 2), a drive assembly having a main shaft (29 and 34)(see col. 5, lines 26-27) and two bearings (see Fig. 6). Hirabayashi doesn't show a third bearing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Hirabayashi's device by providing a third bearing, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

***Allowable Subject Matter***

12. Claims 8 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



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***Conclusion***

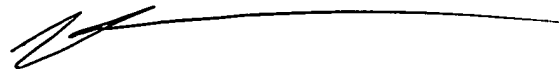
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Toop, Hoffman and McVaugh are cited to show related device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 571-272-4507. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 13, 2004



KENNETH E. PETERSON  
PRIMARY EXAMINER